

REMARKS

This Amendment and Response is submitted in reply to the Final Office Action dated April 9, 2007, in which the Examiner:

rejected claim 1 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2003/0180570 to Cerccone et al.;

rejected claims 1, 3 and 8 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,408,112 to Kazlauskas;

rejected claims 4, 5, 9 and 10 under 35 U.S.C. § 103(a) as unpatentable over Kazlauskas; and

indicated claim 13 would be allowable if rewritten in independent form.

Applicants respectfully traverse the rejections below. Claims 2, 6, 7, 11 and 12 were previously withdrawn in response to a Restriction Requirement; claims 1, 3-5 and 8-10 are currently pending. The current amendment cancels claims 1 and amends claims 3 and 8, and adds claim 14, leaving claims 3-5, 8-10, 13 and 14 pending upon entrance of the current amendment. Claims 3, 8 and 14, directed to various welded portion constitutions, are independent claims.

Claim 3 was rejected under 35 U.S.C. § 102(b) as anticipated by Kazlauskas. An anticipation rejection under 35 U.S.C. § 102 is improper unless a single prior art reference shows or discloses each and every claim recitation. Applicants' claim 3 recites a constitution for a butt-welded portion between tubular members in which a tubular strip is arranged inside of the abutting portion, comprising a contact portion formed on an end portion of at least one of said tubular members in contact with said strip, an inclined portion formed in series with said contact portion and inclined from said contact portion in a direction away from said strip, a stepped portion formed in series with said inclined portion and disposed at a predetermined interval from said strip, and a weld bead provided so as to entirely cover an outer surface of said contact portion and at least partially cover an outer surface of said inclined portion, so as to penetrate a part of an inner surface of said contact portion but not penetrate an inner surface of said inclined portion, wherein said contact, inclined and stepped portions are formed by a bend in said end portion.

Kazlauskas does not show or disclose each and every recitation of Applicants' claim 3. For instance, Kazlauskas does not show or disclose an abutting portion [of two tubular members], inside of which a tubular strip is arranged. Instead, inner insert ring 20 is located *between* Kazlauskas' pipes 10 and 12. (See, e.g., Kazlauskas' Figure 3; col. 2, lines 38-43.) Thus, pipes 10 and 12 both abut the insert ring 20 and *do not* abut each other. Therefore, there is no abutting portion of pipes 10 and 12, unlike the welded portion constitution of Applicants' claim 3.

Additionally, Kazlauskas does not show or disclose contact, inclined and stepped portions are formed by a bend in an end portion of either pipe 10, 12. The Examiner asserts, however, that "the prior art structure can be formed by a bending operation, even if the prior art does not explicitly state how or offers a different method of forming a bent shape." (Final Office Action, p. 4.) Applicants respectfully disagree. First, Applicants' claim recitation, "formed by a bend in said end portion," does not necessarily require that a bend be formed by a "bending operation," as the Examiner appears to imply. Second, there is *no* "bent shape" in an end portion of either of Kazlauskas' pipes 10, 12, whether formed by a "bending operation" or otherwise. Instead, there is a chamfered section 14. Chamfered section 14 is *not* a bent shape, regardless of how it was formed.

Furthermore, Kazlauskas does not show or disclose a weld bead provided so as to entirely cover an outer surface of said contact portion and at least partially cover an outer surface of said inclined portion, so as to penetrate a part of an inner surface of said contact portion but not penetrate an inner surface of said inclined portion.

Thus, Kazlauskas does not show or disclose each and every recitation of Applicants' claim 3. Accordingly, Applicants respectfully submit that the rejection of claim 3 under 35 U.S.C. § 102(b) as anticipated by Kazlauskas is improper for at least this reason, and should be withdrawn.

Claim 8 was rejected under 35 U.S.C. § 102(b) as anticipated by Kazlauskas. Applicants' claim 8 recites a constitution for a fillet-welded portion between a sheet material and a base material, comprising a contact portion formed on an end portion of said sheet material in contact with said base material, an inclined portion formed in series with said contact portion and inclined from said contact portion in a direction away from said base material, a stepped portion formed in series with said

inclined portion and disposed at a predetermined interval from said base material, and a weld bead provided so as to entirely cover an outer surface of said contact portion and at least partially cover an outer surface of said inclined portion, so as to penetrate a part of an inner surface of said contact portion but not penetrate an inner surface of said inclined portion, wherein said contact, inclined and stepped portions are formed by a bend in said end portion.

Kazlauskas does not show or disclose each and every recitation of Applicants' claim 8. For instance, Kazlauskas does not show or disclose a constitution for a fillet-welded portion between a sheet material and a base material. Instead, Kazlauskas discloses an in-line weld of two pipes 10, 12, neither one of which pipes is properly considered a sheet material.

Additionally, Kazlauskas does not show or disclose contact, inclined and stepped portions are formed by a bend in an end portion of either pipe 10, 12, for at least the same reasons discussed in connection with the similar recitation of Applicants' claim 3.

Furthermore, Kazlauskas does not show or disclose a weld bead provided so as to entirely cover an outer surface of said contact portion and at least partially cover an outer surface of said inclined portion, so as to penetrate a part of an inner surface of said contact portion but not penetrate an inner surface of said inclined portion.

Thus, Kazlauskas does not show or disclose each and every recitation of Applicants' claim 8. Accordingly, Applicants respectfully submit that the rejection of claim 8 under 35 U.S.C. § 102(b) as anticipated by Kazlauskas is improper for at least this reason, and should be withdrawn.

Claims 4, 5, 9 and 10 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kazlauskas. A rejection under 35 U.S.C. § 103 is improper unless the Examiner establishes a *prima facie* case of obviousness. A *prima facie* case of obviousness is not established unless the prior art references, alone or in combination, teach or suggest each and every claim recitation.

Claims 4, 5, 9 and 10 each depend directly from either independent claim 3 or 8, and include additional recitations thereto. Kazlauskas does not teach or suggest each and every claim 3 or 8 recitation. For example, Kazlauskas does not teach or suggest an inclined portion formed by a bend in an end portion of one of the weld

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members. Instead, Kazlauskas teaches chamfering, or cutting, the free ends of pipes 10 and 12. Additionally, Kazlauskas does not teach or suggest an abutting portion of two tubular members, as recites by claim 3, or the sheet material of claim 8.

Furthermore, Kazlauskas does not teach or suggest a weld bead provided so as to entirely cover an outer surface of said contact portion and at least partially cover an outer surface of said inclined portion, so as to penetrate a part of an inner surface of said contact portion but not penetrate an inner surface of said inclined portion.

Thus, Kazlauskas does not support a *prima facie* case of obviousness for Applicants' claims 3 or 8. Accordingly, Applicants respectfully submit that the rejection of dependent claims 4, 5, 9 and 10 under 35 U.S.C. § 103(a) as unpatentable over Kazlauskas is improper for at least this reason, and should be withdrawn.

Applicants respectfully submit that nothing in the current Amendment constitutes new matter. Amendments to claims 3 and 8 are supported by at least paragraphs [0055] and [0061] of the Specification, and Figures 1 and 6(b). New claim 14 is supported by at least paragraphs [0057] and [0076] of the Specification, and Figures 1 and 5.

To further prosecution, Applicants note that Kazlauskas does not show, disclose, teach or suggest Applicants' new claim 14 recitations. While Applicants cannot find a bend in an end portion of any of Kazlauskas welded members, Applicants submit that no structure in the end portion of any of Kazlauskas welded members (bent or otherwise) increases the effective height of any of Kazlauskas' welds.

Having traversed each and every rejection, Applicants respectfully request that the rejections of claims 3-5 and 8-10 be withdrawn, and claims 3-5, 8-10, 13 and 14 be passed to issue.

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Applicants believe that no fees are due in connection with this Amendment and Response, beyond those already submitted in connection with the RCE and one-month extension of time. If any fees are deemed necessary, authorization is hereby granted to charge any such fees to Deposit Account No. 13-0235.

Respectfully submitted,

By /Marina F. Cunningham/
Marina F. Cunningham
Registration No. 38,419
Attorney for Applicant(s)

McCORMICK, PAULDING & HUBER LLP
CityPlace II, 185 Asylum Street
Hartford, CT 06103-3402
(860) 549-5290
Customer No.: 35301